REMARKS

Claims 1-16 are now present in the case. Consideration of the application in view of the following remarks is respectfully requested.

On page 2 of the office action, the Examiner rejected Claims 1-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Bezos (U.S. Patent No. 6,029,141, in view of Pettersen (U.S. Patent No. 6,826,594). In particular, the Examiner contends that receiving, mapping, assigning, populating, tracking, communicating, refining and optimizing are expressly disclosed by Bezos, and that while Bezos does not teach selecting, broadcasting and dynamically generating, these steps are taught by Pettersen, and that it would be obvious to combine Pettersen with Bezos. On page 7, the Examiner also rejected Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Bezos (U.S. Patent No. 6,029,141, in view of Pettersen (U.S. Patent No. 6,826,594), and in further view of Official Notice.

Applicants respectfully traverse the rejection of claims 1-16. Applicants submit that claims 1-16 are patentable under 35 U.S.C. § 103(a) over Bezos in view of Pettersen because 1) the Examiner has improperly combined the references of the prior art, and 2) even if the references were combined, they do not disclose the claimed invention.

Improper Combination

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q. 871 (C.C.P.A. 1981). But it "cannot be established by combining the teachings of the prior art to

produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., 732 F.2d at 1577, 221 U.S.P.Q. at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none.

Instead, the Examiner relies on hindsight in reaching his obviousness determination. But the courts have said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F.2d at 1533, 220 U.S.P.Q. at 312-13. It is essential that "the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

The Examiner contends that "At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the method of Bezos to have included the teachings of Pettersen as discussed above in order to increase the effectiveness of advertising on the Internet (Pettersen: column 3, lines 57-67)." However, the present invention is not directed to the presentation of banner ads and advertising. Moreover, the system of Bezos is directed to a customer referral system not an advertising system. Thus, the Applicants believe the Examiner has fallen victim to the insidious effect of hindsight, and there is no suggestion or motivation to combine the prior art references as the Examiner has. Moreover, the Applicants

believe the Examiner is picking and choosing from isolated teachings in the prior art which is improper.

Combination of Bezos and Pettersen

Applicants submit that the Examiner has not established the prima facie case of unpatentability under 35 U.S.C. § 103(a). The "prior art reference (or references when combined) must teach or suggest ALL the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the Applicant's disclosure." MPEP 706.02(k).

Applicants submit that even if combined, Bezos and Pettersen do not yield the claimed invention. Claim 1 recites:

(A) receiving product information into a product information database of a computer system;
(B) mapping said product information into product categories, in a product category database in said computer system;
(C) assigning said product information into a template, said template having an appearance and one or more features;
(D) populating said template with said product information;
(E) selecting a group of online marketplaces, dynamically adjusting said template appearance and features based on said selected group of on-line marketplaces;
(F) broadcasting said populated template to said group of online marketplaces;
(G) dynamically generating a custom product page based on said populated template and an identified on-line marketplace from said selected group of on-line marketplaces for each individual product from said product information database to be marketed on one or more of said on-line marketplaces;
(H) tracking activity on said broadcasted templates, and recording said tracked activity in an activity database in said computer system;
(I) communicating said activity to a client; and
(J) refining an online marketplace selection criteria, wherein said refining further comprises analyzing product placement activity, sales transactions

> and e-commerce marketplace filters of one or more of said selected on-line marketplaces; optimizing an e-commerce channel mix and product offerings by placing said product template in an appropriate time and on one or more of said selected on-line marketplaces based on said product placement and said sales transactions.

Applicants submit that the Examiner has mischaracterized Bezos, Bezos does not teach at least the steps of: mapping, assigning, populating, refining and optimizing.

Claim 1 recites: "mapping said product information into product categories, in a product category database in said computer system." The Examiner contends Bezos discloses this step in claims 23 to 25. Applicants respectfully disagree. Claims 23-25 are directed to a method of operating a virtual store. There is no disclosure of mapping product information into product categories. Furthermore, the terms "mapping", "product information" and "product categories" are not even used in these claims. Thus applicants submit that this step is not taught or suggested by either Bezos or Pettersen.

Claim 1 recites: "assigning said product information into a template, said template having an appearance and one or more features;" and further recites "populating said template with said product information." The Examiner contends Bezos discloses these steps in at least Figure 6 and column 11, lines 43-62. Applicants respectfully disagree. Figure 6 shows a screen displaying an HTML catalog document (web page). Column 11, lines 43-62 describes that web page and it constituent elements. There is no discussion whatsoever that this is a template or that it is populated, or that the product information is assigned to the template (not the web page). Thus applicants submit that this step is not taught or suggested by either Bezos or Pettersen

Claim 1 also recites: "refining an online marketplace selection criteria, wherein said refining further comprises analyzing product placement activity, sales transactions and e-commerce marketplace filters of one or more of said selected on-line marketplaces; optimizing an e-commerce channel mix and product offerings by placing said product template in an appropriate time and on one or more of said selected on-line marketplaces based on said product placement and said sales transactions." The Examiner contends Bezos discloses the steps of refining and optimizing at least at column 3, lines 26-41. Again, Applicants respectfully disagree. The closest item in those paragraphs that can even be considered similar is setting "up outgoing links to the merchant's web site." However, that is not "refining an online marketplace selection criteria" or "optimizing an e-commerce channel mix and product offerings" as recited in the claim. To suggest otherwise would completely read words out of the claim. Therefore, Applicants submit that this step is not taught or suggested by either Bezos or Pettersen.

Applicants note that claim 1 requires both "selecting a group of online marketplaces, dynamically adjusting said template appearance and features based on said selected group of on-line marketplaces," and "dynamically generating a custom product page . . ." The Examiner contends that Pettersen teaches the step of "selecting a group of online marketplaces." However, Applicants disagree, can find no reference in Pettersen to on-line market places, and note that the Examiner did not cite any portion of Pettersen as doing so. This deficiency is not cured by Bezos. Therefore, the Applicants submit that this step is not taught or suggested by either Pettersen or Bezos.

Thus, based on the numerous and significant distinctions between the art of record and the claims invention as has just been noted, Applicants respectfully submit that claim 1 is patentably distinct over the art of record and therefore in a condition for allowance. Applicants respectfully request the allowance of claim 1.

Applicants note that Examiner contends that Applicants did not traverse the Examiner's assertion of Official Notice with respect to claim 15 and that the Official Notice statement that particular areas of expertise are functionally equivalent to multiple e-commerce marketplace sites is taken to be admitted prior art. Applicants respectfully disagree. Since Applicants present arguments regarding Aggarwal, and that the cited art did not make obvious the claims invention, Examiners contentions regarding Official Notice were moot and not addressed. For the sake of clarity, Applicants make no admissions regarding prior art other that those explicitly made herein. For example, Applicants believe that Pettersen is not properly prior art since Applicants conceived of there invention before the critical date of Pettersen, however, since the Applicants believe that he combination of Petterson with Bezos as has been noted above does not teach the claimed invention that argument, like many others, is not raised here but is preserved for presentation at a later time to the extent necessary.

Claims 2-16 depend, either directly or indirectly from claim 1. Claims 2-16 also include recitations that further defined the claimed invention such as but not limited to storing client information, sending an email, sending report information, and dynamically modifying content. Based on their dependence on claim 1 and other patentable recitations, claims 2-16 are also believed to be patentable.

Conclusion

In sum, Applicants respectfully submit that claims 1-16, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicants request reconsideration and allowance of these claims. In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully submitted,
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Dated: 3/13/06

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24466/10449/DOCS/1602809.1